

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RICHARD N. FARGO, MATTHEW JOHN DUNLAVEY; MICHAELPAUL COSTA
and CATALIN H. POPA

Appeal No. 2004-0389
Application No. 09/853,339

ON BRIEF

Before COHEN, ABRAMS and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 14. Claim 13 has been canceled and claims 2-12 and 15-26 stand withdrawn as not being directed to elected species.

We affirm-in-part and enter a new ground of rejection.

BACKGROUND

The appellants' invention relates to a support structure for an escalator. Appellants' specification discloses several embodiments of the invention. In response to an election of species requirement (Paper No. 5), appellants elected the embodiment of Figure 11 (Paper No. 7). Further understanding of the invention may be obtained from a reading of independent claim 1, which is reproduced, infra, in the opinion section of this decision.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Pallinger et al. (Pallinger)	6,105,748	Aug. 22, 2000
Gschwendtner et al. (Gschwendtner)	6,374,981	Apr. 23, 2002 (filed Aug. 1, 2000)

The following rejections are before us for review.¹

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Gschwendtner.

¹ The withdrawal of claims 19-26 as not being directed to the elected species relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by appellants on pages 9 and 10 of the brief.

Claim 1 stands rejected under 35 U.S.C. § 102(b)² as being anticipated by Pallinger.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gschwendtner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 14 and 16) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1, the sole independent claim before us on appeal, reads as follows:

1. A support structure assembly for an escalator comprising:
a bottom landing support;
a top landing support; and

² We note that the Pallinger patent was issued less than one year prior to the filing date of the present application and thus does not appear to be available as prior art under 35 U.S.C. § 102(b) against the present application. Nevertheless, as appellants have not challenged the applicability of the Pallinger patent as prior art under 35 U.S.C. § 102 and as it does appear to qualify as prior art against the present application under 35 U.S.C. § 102(e), we shall treat this rejection as a rejection under 35 U.S.C. § 102(e). In light of our reversal of this rejection, *infra*, appellants do not appear to be prejudiced by this treatment of the rejection.

a rise for interconnecting said bottom landing support to said top landing support wherein said rise includes at least one module wherein the module comprises a steel sheet covering an escalator machine, said steel sheet presenting a continuous planar exterior surface.

We turn our attention first to the examiner's rejection of claim 1 as being anticipated by Pallinger. Pallinger discloses an escalator or traveling walkway with underneath bracing. The escalator comprises transport means in the form of steps bounded laterally by balustrades 5 each supporting a moving handrail 6. According to Pallinger (column 2, lines 4-7),

[a] pair of support bodies 7 serves as a support means for the plates 4 or steps, and has beam lower edges 8 to which underneath bracing 9 is connected at intervals.

Pallinger also discloses that the escalator or traveling walkway shown in Figure 1 has one support 15 "at each beam lower edge 8" (column 2, lines 28-29).

Appellants argue on page 7 of their brief that Pallinger teaches the use of beams, not a steel sheet as called for in appellants' claim 1. On page 6 of their reply brief, appellants add that Pallinger's Figures 1-4 show an exterior cladding 7 which is mounted above, but does not cover, the escalator support structure and point out that Pallinger provides no teaching that such cladding is made of steel.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between

the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Based on our reading of Pallinger, we find ourselves in agreement with appellants that Pallinger appears to disclose support bodies 7 in the form of beams, not sheets, much less a steel sheet, as called for in claim 1. Having concluded that Pallinger fails to disclose each and every element of claim 1, it follows that we cannot sustain the examiner's rejection of claim 1 as being anticipated by Pallinger.

We turn next to the examiner's rejection of claim 1 as being anticipated by Gschwendtner. Appellants argue that Gschwendtner fails to disclose a support structure comprising a module comprising a steel sheet covering an escalator machine and presenting a continuous planar exterior surface, as called for in claim 1. In particular, appellants urge that Figure 1, referenced by the examiner for its presentation of a continuous planar exterior surface (answer, page 4), does not show the support structure of the escalator and, at best, schematically shows an outside cover over the truss structure of Figure 2. Appellants also point out that the solid steel plates forming supplementary wall supports 21 in Figure 8 (also referred to by the examiner on page 4 of the answer) are provided with passage openings 22 and thus do not present "a continuous planar exterior surface" as called for in claim 1. See page 6 of the brief. For the reasons which follow, we do not find these arguments persuasive.

Each of the solid steel plates forming supplementary wall supports 21, shown in Figure 8 of Gschwendtner, comprises a steel sheet “presenting a continuous planar exterior surface,” as called for in claim 1. We note that claim 1 does not require that the steel sheet be free of passages or discontinuities but simply that it present a continuous planar exterior surface. Gschwendtner’s solid steel plates forming wall supports 21 clearly comprise portions which present continuous planar surfaces, such as the portions above and below and between the passage openings 22, for example.³

Appellants may be correct that Figure 1 simply schematically shows an outside cover over the truss structure of Figure 2. This, however, does not alter our view that the supplementary wall supports 21 of Figure 8 meet the limitations of claim 1 with regard to the steel sheet module. Moreover, it is immaterial that only the supplementary wall support of Figure 8 is formed from a solid steel plate (see brief, page 6), as claim 1 does not preclude the presence of additional structure in the rise.⁴

Appellants also argue that escalator drive machines have typically been located under landings, not along the rise, and that Gschwendtner lacks any showing of an

³ We recognize, as pointed out by appellants on page 7 of their brief, that the steel sheet illustrated in appellants’ Figure 11 is not depicted as having any openings or passages therein. We are also aware that an important feature of appellants’ invention is that it is “a closed design that eliminates the need for exterior cladding” (specification, page 2). We also note that several embodiments of that invention (see Figures 2-7, for example), do comprise openings in the stamped modules and are, nonetheless, presumably also considered to be “a closed design” inasmuch as appellants’ specification does not single out the embodiment of Figure 11 as being the only “closed design” embodiment.

⁴ Specifically, claim 1 recites that “said rise includes at least one module wherein the module comprises a steel sheet.” The transitional terms “comprises” and “includes” are inclusive or open-ended and do not exclude additional, unrecited elements. See *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)(“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”).

escalator machine being located in the rise section of the escalator (brief, page 5). In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Moreover, absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation. Id., 127 F.3d at 1056, 44 USPQ2d at 1029. Appellants have not defined "escalator machine" in their specification as being limited to the drive motor and, further, have not disclosed that the drive motor of their invention is located differently than in conventional escalators. Thus, we interpret an "escalator machine" as including the conveying plates or steps. As Figure 3 of Gschwendtner shows the standard and supplementary wall supports flanking the conveying plates of the escalator, we consider this to meet the limitation "covering^[5] an escalator machine" as called for in claim 1.

⁵ The term "cover" is understood to mean "to extend over" or "overlay" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988) and does not require complete enclosure, as called for in dependent claim 14.

For the foregoing reasons, we find appellants' arguments unpersuasive of any error on the part of the examiner in determining that the subject matter of claim 1 is anticipated by Gschwendtner. Thus, we shall sustain this rejection.

We shall not, however, sustain the examiner's 35 U.S.C. § 103 rejection of claim 14 as being unpatentable over Gschwendtner. For the reasons expressed below, this claim is indefinite. Therefore, the prior art rejection must fall because it is necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

NEW GROUND OF REJECTION

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

Claim 14 recites that the steel sheet module "completely encloses the escalator machine." The terminology "completely encloses" is ordinarily understood to mean surrounding on all sides. As the steel sheet module recited in the claim appears to correspond to the steel sheet 120 illustrated in appellants' Figure 11 and steel sheet 120 only covers the escalator on one side, claim 14 appears to be inconsistent with the underlying disclosure, thereby rendering the claim indefinite under 35 U.S.C. § 112, second paragraph. See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA

1971) (no claim can be read apart from and independent of the supporting disclosure on which it is based and inexplicable inconsistencies between the claim and the underlying disclosure render the claim indefinite).

CONCLUSION

To summarize, the rejection of claim 1 under 35 U.S.C. § 102 as being anticipated by Gschwendtner is sustained and the rejections of claim 14 under 35 U.S.C. § 103 as being unpatentable over Gschwendtner and claim 1 under 35 U.S.C. § 102 as being anticipated by Pallinger are reversed. A new rejection of claim 14 under 35 U.S.C. § 112, second paragraph, is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with

respect to the new ground of rejection to avoid termination of proceedings (37 CFR

§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Carlson, Gaskey & Olds, P.C.
Suite 350
400 West Maple Road
Birmingham, MI 48009